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EXAMINER

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ART UNIT	PAPER NUMBER
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2168

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/26/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/537,935

Applicant(s)

CHOI ET AL.

Examiner

Fariborz Khoshnoodi

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 June 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 June 2005 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>6/8/2005</u> . | 6) <input type="checkbox"/> Other: _____ |

Detailed Action

Drawings

1. The Drawing is objected to because of improper shading for figures 1a, 1b, 3-5, 11-13, and 16 CFR 1.84 (a) (1) dictates the sole use of black and white drawings. Gray shading is not permitted. According to 37 CFR 1.84 (m), shading must be in the form of thin lines spaced closely together. Appropriate correction is required.

Claim Rejections - 35 USC § 101

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claim 1 (and their dependent claims, where applicable) are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.
3. Claim 1 (and their dependent claims, where applicable) is directed to a method, program and system for ***an apparatus to associate resources using a behavior based algorithm***. This claimed subject matter lacks a practical application of a judicial exception (law of nature, abstract idea, naturally occurring article/phenomenon) since it fails to produce a useful and tangible result because the claimed subject matter fails to sufficiently reflect at least one practical utility set forth in the descriptive portion of preamble, e.g., ***an apparatus to associate resources using a behavior based algorithm***. More specifically, while describes practical utility (utilities) is (are) directed to

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“arranging said at least one portion of the search list orders according to the predetermined search list order display methods when arranging the identified search list orders”, the claimed subject matter relates ONLY to arrange search list order and a display method but, there is no indication of generating the arranged search list order. Therefore the claimed invention is not generating tangible result. Appropriate changes required.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office Action:

A person shall be entitled to patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1-6 and 28-30 are rejected under 35 U.S.C. § 102(e) as being anticipated by Tadashi Goino United States Patent Publication No. 2001/0056396 A1.

As per claim 1:

Goino teaches a method comprising: **receiving bidding prices and tender conditions including keywords and predetermined search list order display methods from network information providers, and making a successful bid for the keywords based on the tender conditions and the bidding prices, to sell the keywords associated with the predetermined search list order display methods through a tender (i.e., “Also, the bid**

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condition data D3, D4 received in this event are stored in the time bid data storage unit 45A if they are related to the time slide scheme and the price slide setting type, and in the narrow-down data storage unit 45B, if they are narrow-down condition data for use in narrowing down bidders. The procedure from S20 to S100 corresponds to a request procedure." (Par. 131 lines 7-14)); **associating at least one portion of the search list orders with the keywords and the predetermined search list order display methods, to maintain a database including a plurality of search list orders** (i.e., "For example, when information desired by a user is transmitted to the server 21, the server 21 searches the management data in the bid management DB 23 for pertinent information, and immediately collects the information when the information is not urgently required so that a collection time is allowed to some extent." (Par. 370 lines 1-6)... The list XC1 indicates a priority number, a code number, and a numerical value (length, height, area, volume, bulk, weight, amount and so on), price, conditions offered by a bidder (supplementary items (extra) and so on)." (Par. 371 lines 14-18)); **receiving a search request from a searcher** (i.e., "a bid procedure in which said server receives bid information including said element or said converted information offered by bidders from terminals of the bidders through communications via the

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network" (Par. 18)); identifying search list orders associated with keywords corresponding to the search request (i.e., "More specifically, upon receipt of data of new bids, the control unit 42 reads time condition data (here conditions for the time slide scheme) from the time bid data storage unit 45A in the article management database 23, and also reads all bid data associated with an article code number involved in this auction from the bid management database 24."Par. 137 lines 7-12)); and arranging said at least one portion of the search list orders according to the predetermined search list order display methods when arranging the identified search list orders (i.e., "However, if the time condition consists only of the period specified by the client, the priority list is created by arranging bidders in order from the one which was accepted first. In this event, all bidders are determined as successful bidders." (Par. 144 lines 17-21)).

As per claim 2:

Goino teaches a method, wherein the predetermined search list order display methods are specified by a form of display and ranking of the search list orders (i.e., "For example, the server 21 lists information offered by bidders as it is, or creates a priority list by narrowing down successful bidder candidates at higher ranks, for example, to a limited number of bidders specified by the client based on the

information offered by the bidders, and transmits the list to the terminal 30A of the client. Accordingly, a list screen XA as illustrated in FIG. 14 is displayed on the terminal 30A of the client." (Par. 151 lines 3-9)).

As per claim 3:

Goino teaches a method, wherein said at least one portion of the search list orders is randomly arranged in a placement zone specified by the search list order display method when arranging said at least one portion of the search list orders (i.e., "On the other hand, if it is determined in S2060 that the bid collection "no" is specified, bid information is collected in S2100. Specifically, the bid registration data D19 or the bid information data D20 previously managed as databases in the DBs 145, 147 are searched to extract previously registered articles or services pertinent to the specified article or service." (Par. 504)).

As per claim 4:

Goino teaches a method, wherein predetermined keywords are sold during only a predetermined period of time through the tender (i.e., "FIG. 1 illustrates a time auction system for sellers and buyers to conduct auctions for articles through a network. In this example, an auction is

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held in which an article is bid for with time as an element." (Par. 101 lines 3-6)).

As per claim 5:

Goino teaches a method, **wherein the step of selling the keywords through the tender is individually performed for each of said at least one portion of the search list orders** (i.e., "As a trade is established, a client and a successful bidder proceed with payment for an article and delivery of the article. The entry fields S2, S3 are fields for setting a specific request from the client on a trading date offered by a successful bidder in the payment or the delivery of the article. The entry field S2 for "payment" is available when a client is a seller, while the entry field S3 for "article delivery" is available when a client is a buyer." (Par. 117)).

As per claim 6:

Goino teaches a method, **wherein remaining search list orders except said at least one portion of the search list orders are arranged independent of the predetermined search list order display method** (i.e., "On the other hand, if it is determined in Step S712 that the bid-off self selection is set, the list screen XB illustrated in FIG. 29 is displayed in S714 for enumerating bid information of a predetermined number of bidders in a list form. The user can view the list screen XB by selecting a screen display after entering a password on the

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screen of the terminal 30. The list screen XB enumerates candidates in a priority order in terms of the position (displayed as the code number), so that the user can determine a trading partner while referencing other information offered by the bidders." (Par. 266 lines 1-11)).

As per claim 28:

Goino teaches a method comprising: **receiving keywords and bidding prices from network information providers** (i.e., "a bid procedure in which said server receives bid information including said element or said converted information offered by bidders from terminals of the bidders through communications via the network;" Par. 18)); **selecting a successful bidder among a plurality of network information providers associated with the keywords according to a predetermined criterion associated with the bidding prices** (i.e., "a bid acceptance procedure in which said server executes bid processing for finding a result of bidding with said element included in said bid information or an element derived by converting said converted information, based on said bid information, to select a successful bidder." (Par. 19)); **receiving a web page title, a web page description and an image file associated with a web page of the successful bidder from the successful bidder** (i.e., "an attribute of an object used in utilization of a person who receives the offered

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service. The attribute can help differentiate from other articles and services. The attribute includes, for example, design, contents of service, specification, model number, performance, effect, quality, material, strength, reliability, taste, smell, fragrance, color, brightness, illuminance, sound volume, sound quality, temperature, pressure, size, component, log, career, title, capability, speed, length, weight, volume, bulk, area, nature, point, shape, pattern, coloring, type, system, product name, article name, and so on. " (Par. 711 lines 5-16)); **generating search list orders in real time substantially by combining the web page title, the web page description and the image file, and offering the generated search list orders to the successful bidder** (i.e., "Then, the time bid computing unit 43 uses these data to compare trading dates presented in respective data with one another to create a priority list which enumerates bidders in a priority order for each of the periods." (Par. 144 lines 11-14)); **receiving a confirmation input of the successful bidder for the generated search list orders** (i.e., "Then, the bidder who has offered the trading date that most satisfies a time condition is selected as a successful bidder candidate. However, if the time condition consists only of the period specified by the client, the priority list is created by arranging bidders in order from the one which was accepted

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first."(Par. 144 lines 14-20)); **associating the keywords with the search list orders** (i.e., "The article list screen U displays a photograph U1 and an article code number of each article, as well as article related information such as article name, desired price, quantity, and so on."(Par. 134 lines 1-4)); **receiving a search request from the searcher** (i.e., "It should be noted that the procedure in S310, wherein the bid screen is displayed on terminals 30 of bidders, and the server 21 receives the bid data D5 upon acceptance of applied bids, corresponds to a bid acceptance procedure."(Par. 144 lines 21-25)); **identifying search list orders associated with a keyword corresponding to the search request** (i.e., "the successful bidder candidates on the priority list created by the time bid computing unit 43 are narrowed down to the limited number of bidders from the top of the list which are determined as successful bidders."(Par. 148 lines 1-5)); **and offering the identified search list orders to the searcher by arranging the identified search list orders in a predetermined position of a search result web page** (i.e., "The time auction HP illustrated in FIG. 3 classifies potential articles traded thereon into marketable securities, real estate, condominium for sale, ticket, new product, antique and art objects, and so on. As a person clicks on a button 51 or 52 associated with an

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article which he wants to sell at auction, the article list screen U illustrated in FIG. 9 is displayed on the terminal 30. The button 51 is provided for auction, while the button 52 is provided for Counter-auction." (Par. 133)).

As per claim 29:

Goino teaches a method further comprising the steps of: **receiving a correction request for one or more of a web page title, a web page description and an image file from the successful bidder** (i.e., "A client (for example, a seller) confirms a bidding situation on the screen of his terminal 30A and transmits a bid acceptance indication to the server 21 when a successful bidder candidate offers a desired trading date, even before the expiration of a bidding period. Conversely, when there is no bidders even if the client confirms a bidding situation on the screen, or when no bidder has offered desired conditions for a long time, the bid conditions (due date (period), price, and so on) may be changed even before the expiration of the bidding period." (Par. 138)); **and correcting the search list orders in real time substantially in response to the correction request and offering the corrected search list orders to the successful bidder** (i.e., "(i.e., "In S230, when the server 21 receives a bid acceptance indication from the client, the flow continues to S270. In S240, if the server 21

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receives an instruction to change the bid conditions from the terminal 30A of the client, the bid condition data stored in the bid condition storage unit 45 is changed."(Par. 139 lines 1-6)).

As per claim 30:

Goino teaches a method comprising: **a tender conditions receiving unit for receiving tender conditions including keywords and search list order display methods, and bidding prices from network information providers** (*i.e.*, "As a result of an auction, information on a single successful bidder is basically transmitted to the client. However, if the client wishes, a plurality of narrowed down candidates may be presented, as illustrated in a list screen XD of FIG. 64. Specifically, the server 21 creates information offered by bidders, as it is, into a list, or creates a priority list by narrowing down successful bidder candidates of higher priority levels, for example, into a limited number specified by the client, based on information offered by bidders, and transmits the created list to the terminal 30 of the client."(Par. 573 lines 1-11)); **a successful bid making unit for making a successful bid for the keywords based on the tender conditions and the bidding prices** (*i.e.*, "The list XD1 indicates a priority number, a code number, and an element numerical value (values representative of time, position, space, weight, evaluation and

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so on), and conditions offered by a bidder (price, supplementary items (extra) and so on). The client reviews the offered conditions such as a trading date from the list XD1 on the screen XD to determine a bidder favorable for him as a successful bidder, enters, for example, the priority number of the winning bidder in the entry field XD2, and selects the decision button 192." (Par. 573 lines 14-23)); **a storing unit including a plurality of search list orders** (i.e., "The server 21 stores on its hard disk screen data for the variety of screens HP, P, Q, R, S, T, a program for use in displaying the screens and so on (for example, an HTML description program), a program for use in computing processing involved in the auction, and so on." (Par. 105 lines 6-11)); **a search performing unit for: associating the plurality of the search list orders with the successfully bidden keywords and search list order display methods** (i.e., "As a person clicks on a button 51 or 52 associated with an article which he wants to sell at auction, the article list screen U illustrated in FIG. 9 is displayed on the terminal 30." (Par. 133 lines 4-7)); **identifying search list orders having the keywords corresponding to the search request in response to a search request received from a searcher** (i.e., "Requirements can be entered in a plurality of different ways, so that the screen E is provided with a sentence entry field E4 for entering a sentence which describes

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requirements; key word registration buttons 161, 162, 163 for identifying requirements with key words; and an evaluation registration list button 164 for identifying requirements by specifying a numerical value or the like for each evaluated item (specifications or the like)."(Par. 463 lines 1-8)); **and arranging at least one portion of the search list orders according to the search list order display methods** (*i.e.*, "As a person clicks on a button 51 or 52 associated with an article which he wants to sell at auction, the article list screen U illustrated in FIG. 9 is displayed on the terminal 30. "(Par. 133 lines 4-7)); **and a search request receiving unit for receiving a search request from a searcher via a communication network** (*i.e.*, "a bid procedure in which said server receives bid information including said element or said converted information offered by bidders from terminals of the bidders through communications via the network;"(Par 18)).

6. Claims 9-15, 17-19, 21-23, 26-27, and 31 are rejected under 35 U.S.C. § 102(e) as being anticipated by Singh et al. United States Patent Publication No. 2002/0166849 A1.

As per claim 9:

Singh et al. teach a method comprising: **maintaining a plurality of search list orders including URLs associated with network information providers** (*i.e.*, "In a

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preferred embodiment of the present invention, the search engine web server 24 generates a search result list that includes, at least in part, relevant entries obtained from and formatted by the results of the bidding process conducted by the account management server 22. The search engine web server 24 generates a list of hypertext links to documents that contain information relevant to search terms entered by the user at the client computer 12. The search engine web server transmits this list, in the form of a web page, to the network user, where it is displayed on the browser 16 running on the client computer 12." (Par. 196 lines 8-19)); **receiving keywords associated with the search list orders and bidding prices associated with the keywords from the network information providers** (i.e., "Since advertisers must pay for each click-through referral generated through the search result lists generated by the search engine, advertisers have an incentive to select and bid on those search keywords that are most relevant to their web site offerings." (Par. 15 lines 15-19)); **selecting a successful bidder among a plurality of network information providers associated with the keywords according to a predetermined criterion associated with the bidding prices after a tender period of time expires** (i.e., "A cost condition monitors the total CPC expenditures for one or more listings of the advertiser in a given time interval. At the start of every time interval the

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accumulated costs are zero. The starting point of each time interval is at the discretion of the marketplace operator. For example, all hourly intervals could start at the start of every half hour. Each cost condition has the following parameters: 1. listings: one or more listings whose CPC expenditure is being monitored. 2. limit: the expenditure limit for the accumulated CPCs for all the listings, e.g., \$300.00. 3. interval: the time period for the limit, e.g., one week. The following are all examples of cost conditions: 1. "The CPC charges for listing L.sub.1 exceed \$300.00 in any hour" listings: L.sub.1, limit: \$300.00, interval: 1 hour" (Par. 64 through Par. 69)); and generating a search result list including at least a portion of the plurality of search list orders in response to the search request, wherein at least one portion of the plurality of search list orders is arranged in a predetermined search list order placement position (i.e., "In this on-line marketplace, companies selling products, services, or information bid in an open auction environment for positions on a search result list generated by an Internet search engine. Since advertisers must pay for each click-through referral generated through the search result lists generated by the search engine, advertisers have an incentive to select and bid on those search keywords that are most relevant to their web site offerings." (Par. 15 lines 12-19)).

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As per claim 10:

Singh et al. teach a method, **wherein the search list order placement position is determined before the bidding prices are received from the network information providers** (i.e., *"The openness of this advertising marketplace is further facilitated by publicly displaying, to consumers and other advertisers, the price bid by an advertiser on a particular search result listing."* (Par. 15 lines 23-26)).

As per claim 11:

Singh et al. teach a method, **further comprising the step of receiving information on a predetermined display period of time from the network information providers, wherein when the network information providers are selected as a successful bidder, search list orders associated with the network information providers are arranged in the predetermined search list order placement position during the predetermined display period of time, and a position of the arranged search list orders is not changed** (i.e., *"The openness of this advertising marketplace is further facilitated by publicly displaying, to consumers and other advertisers, the price bid by an advertiser on a particular search result listing."* (Par. 15 lines 23-26)).

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As per claim 12:

Singh et al. teach a method, **wherein the step of selecting the successful bidder includes selecting a plurality of the network information providers as successful bidders, wherein said at least one portion of the search list orders is arranged according to rankings determined by the bidding prices of the successful bidders within a placement zone specified by the search list order display methods** (*i.e.*, "The "View Search Term List" selection displays the list of the advertiser's selected search terms along with the corresponding URLs, bid price, and rank, with the search terms preferably grouped by subaccount. The advertiser may also view current top bids for a set of search terms selected from a list of search terms from a read-only display generated by the system upon receiving the requested search terms from the advertiser." (Par. 248 lines 3-12)).

As per claim 13:

Singh et al. teach a method, further comprising the steps of: **offering instant purchase prices to network information providers** (*i.e.* "An automated voice synthesis system can be used to alert the advertiser to the conditions that are/were true. The phone means can offer corrective actions in a menu with touch-tone inputs, *e.g.*, "press 1 to increase your bid to one dollar and thirty two cents to regain

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position 1, press 2 to..." (Par. 157 lines 2-8)); and instantly selecting the network information providers as successful bidders if the instant purchase prices are received as the bidding prices from network information providers (i.e., "After the system calculates the new bid price and presents a read-only confirmation display to the advertiser, the system updates the bid prices and rank values upon receiving approval from the advertiser." (Par. 240 lines 18-21)).

As per claim 14:

Singh et al. teach a method, wherein the instant purchase prices are determined in consideration of past successful bid prices of the keywords (i.e., "The "View Search Term List" selection displays the list of the advertiser's selected search terms along with the corresponding URLs, bid price, and rank, with the search terms preferably grouped by subaccount." (Par. 248 lines 5-9)).

As per claim 15:

Singh et al. teach a method, wherein the step of selecting the successful bidder further includes the step of regarding a successful bid as an unsuccessful bid in at least one of the followings: a case where a purchase rejection intention is received from the successful bidder, a case where the successful bidder does not purchase a successful bidden keyword within a predetermined period of time, and a case where a purchase rejection intention is

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once again received after the predetermined period of time expires (i.e., "A cost condition monitors the total CPC expenditures for one or more listings of the advertiser in a given time interval. At the start of every time interval the accumulated costs are zero. The starting point of each time interval is at the discretion of the marketplace operator. For example, all hourly intervals could start at the start of every half hour. Each cost condition has the following parameters: 1. listings: one or more listings whose CPC expenditure is being monitored. 2. limit: the expenditure limit for the accumulated CPCs for all the listings, e.g., \$300.00. 3. interval: the time period for the limit, e.g., one week. The following are all examples of cost conditions: 1. "The CPC charges for listing L.sub.1 exceed \$300.00 in any hour" listings: L.sub.1, limit: \$300.00, interval: 1 hour" (Par. 64 through Par. 69)).

As per claim 17:

Singh et al. teach a method, wherein if a plurality of same bidding prices are received, the successful bidder is selected in consideration of at least one of a tender sequence, a display period of time, an actual advertisement use result, a credit of network information providers (i.e., "If the payment type is credit card, the user's account is credited immediately at step 616, the user's credit

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card having already been validated in step 610. A screen showing the status of the add money transaction is displayed, showing a transaction number and a new current balance, reflecting the amount added by the just completed credit card transaction."(Par. 225)).

As per claim 18:

Singh et al. teach a method, further comprising the step of determining the lowest limit bidding price, wherein the lowest limit bidding price is determined in consideration of at least one of a page view, a basic unit price and a weight *(i.e., " In the case where the bid of the listing ranked below theirs has decreased, some advertisers may wish to lower their bid to reduce the amount they pay while still maintaining their position in the results set."*(Par. 18 lines 17-20)).

As per claim 19:

Singh et al. teach a method, further comprising the step of opening the highest bidding price or a bidding price list *(i.e., "The higher bids receive more advantageous placement on the search result list page generated by the search engine 24 when a search using the search term bid on by the advertiser is executed."*(Par. 199 lines 1-4)).

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As per claim 21:

Singh et al. teach a method, **further comprising the step of offering keywords similar to keywords received from the network information providers to the network information providers** (*i.e.*, "Search services are, after e-mail, the most frequently used tool on the Internet. As a result, web sites providing search services have offered advertisers significant reach into the Internet audience and have given advertisers the opportunity to target consumer interests based on keyword or topical search requests." (Par. 9)).

As per claim 22:

Singh et al. teach a method, **wherein the step of receiving the bidding prices includes the step of limiting the number of receipt of bidding prices from same network information providers to the predetermined number of times or demanding an additional price if bidding prices are received above the predetermined number of times** (*i.e.*, "After the system calculates the new bid price and presents a read-only confirmation display to the advertiser, the system updates the bid prices and rank values upon receiving approval from the advertiser." (Par. 240 lines 18-21)).

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As per claim 23:

Singh et al. teach a method, **further comprising the step of offering a result for the search request associated with the keywords to the successful bidder, wherein the result for the search request includes at least one of the number of exposures, the number of clicks and a click rate** (i.e., "In this selection, the advertiser specifies a search listing or subaccount for which the advertiser would like to predict a "daily run rate" and "days remaining to expiration." The system calculates the projections based on a cost projection algorithm, and displays the predictions to the advertiser on a read-only screen. The predictions may be calculated using a number of different algorithms known in the art. However, since the cost of a search listing is calculated by multiplying the bid amount by the total number of clicks received by the search listing at that bid amount during a specified time period, every cost projection algorithm must generally determine an estimated number of clicks per month (or other specified time period) for a search listing." (Par 246 lines 3-16)).

As per claim 26:

Singh et al. teach a method comprising: **receiving web page titles, web page descriptions, image files, keywords and bidding prices associated with web pages of the**

network information providers from network information providers (i.e., "A consumer utilizing a search engine that facilitates this on-line marketplace will find companies or businesses that offer the products, services, or information that the consumer is seeking. In this on-line marketplace, companies selling products, services, or information bid in an open auction environment for positions on a search result list generated by an Internet search engine." (Par. 15 lines 9-15)... "The pages may be constructed in any one of a variety of formatting conventions, such as Hyper Text Markup Language (HTML), and may include multimedia information content such as graphics, audio, and moving pictures. Any person with a computer and a connection to the Internet may access any publicly accessible page posted on the web." (Par. 6 lines 1-7)); **generating search list orders in real time substantially by combining the web page titles, the web page descriptions and the image files, and offering the generated search list orders to the network information providers** (i.e., "Since advertisers must pay for each click-through referral generated through the search result lists generated by the search engine, advertisers have an incentive to select and bid on those search keywords that are most relevant to their web site offerings." (Par. 15 lines 15-19)... "The pages may be constructed in any one of a variety of formatting conventions, such as Hyper Text Markup Language (HTML), and may include

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multimedia information content such as graphics, audio, and moving pictures. Any person with a computer and a connection to the Internet may access any publicly accessible page posted on the web." (Par. 6 lines 1-7)); **receiving confirmation inputs of the network information providers for the generated search list orders** (i.e., "The higher an advertiser's position on a search result list, the higher likelihood of a "referral"; that is, the higher the likelihood that a consumer will be referred to the advertiser's web site through the search result list. The openness of this advertising marketplace is further facilitated by publicly displaying, to consumers and other advertisers, the price bid by an advertiser on a particular search result listing." (Par. 15 lines 20-23)); **selecting a successful bidder among a plurality of network information providers associated with the keywords according to a predetermined criterion associated with the bidding prices** (i.e., "The openness of this advertising marketplace is further facilitated by publicly displaying, to consumers and other advertisers, the price bid by an advertiser on a particular search result listing." (Par. 15 lines 23-26)); **associating the keywords with the search list orders** (i.e., "In response to a received query from a searcher, search listings are located, arranged according to bid and displayed to the searcher. If a searcher selects or clicks through an advertiser's search

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listing, the bid amount is charged to the advertiser by the pay for performance web site operator."(Par. 17 lines 5-10)); **receiving a search request from the searcher** (*i.e.*, "Advertisers can control the position of their search listing in the search result list by adjusting the bid amount associated with the search listing."*(Par. 17 lines 10-12)*); **identifying search list orders associated with a keyword corresponding to the search request** (*i.e.*, "The search engines and web site directories of the prior art, however, rely upon processes for assigning results to keywords that often generate irrelevant search results."*(Par. 10 lines 5-7)*); **and offering the identified search list orders to the searcher by arranging the identified search list orders in a predetermined position of a search result web page** (*i.e.*, "In a preferred embodiment of the present invention, the search engine web server 24 generates a search result list that includes, at least in part, relevant entries obtained from and formatted by the results of the bidding process conducted by the account management server 22. The search engine web server 24 generates a list of hypertext links to documents that contain information relevant to search terms entered by the user at the client computer 12. The search engine web server transmits this list, in the form of a web page, to the network user, where it is

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displayed on the browser 16 running on the client computer

12." (Par. 196 lines 8-19)).

As per claim 27:

Singh et al. teach a method, further comprising the steps of: **receiving a correction request for one or more of web page titles, web page descriptions and image files from the network information providers** (*i.e.*, "It is also important for advertisers to keep track of the click through rate (CTR) of listings. For example, a new title or description for a listing may result in a lower CTR if it is less clear than what was there before. Keeping track of the CTR ensures that corrective action can be taken promptly." (Par. 22)); **and correcting the search list orders in real time substantially in response to the correction request and offering the corrected search list orders to the network information providers** (*i.e.*, "The links can be embedded URLs in an e-mail message, that in one click correct an undesirable condition. For example, a link may be titled "Click here to increase the CPC of the following listing to \$1.43 to restore it to rank 3." The URL of the link points to market operator's system, and includes information about the advertiser and the condition(s) to be corrected. If the advertiser clicks on the link, his identity is verified, and the system performs all the corrective actions automatically without

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requiring the advertiser to interact with the online marketplace system directly." (Par. 160 lines 5-16)).

As per claim 31:

Singh et al. teach a computer-readable recording medium in which a **program for implementing a method according to any one of claims 1 to 29 in a computer is recorded** (i.e., "A compact disc appendix is included containing computer program code listings pursuant to 37 C.F.R. 1.52(e) and is hereby incorporated by reference in its entirety. The total number of compact discs is 1 including 24,443 files and 105,738,488 bytes. The files included on the compact disc are listed in a file entitled "dir_s" on the compact disc. Because of the large number of files contained on the compact disc, the required listing of file names, dates of creation and sizes in bytes is included in the file dir_s on the compact disk and incorporated by reference herein." (Par. 2)).

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

- (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time

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the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 7-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Goino United States Patent Publication No. 2001/0056396A1 in view of Boyd et al. United States Patent Publication No. 2004/0193489 A1.

As per claim 7:

Goino does not explicitly disclose for the keywords sold through the tender are premium keywords determined by a predetermined criterion. However, Boyd et al teach a method, **wherein the keywords sold through the tender are premium keywords determined by a predetermined criterion** (*i.e.*, "Alternatively, the merchandise is sold at the highest bid price when the time period for the auction expires." (Par. 236 lines 5-7)).

Therefore, it would have been obvious to a person in the art at the time the invention was made to modify the method disclosed in Goino to have the keywords sold through the tender are premium keywords determined by a predetermined criterion. This modification would have been obvious because a person having ordinary skill in the art, at the time the invention was made, having the teachings of Goino and Boyd et al. before him/her, to modify the method of Goino to include the keywords sold through the tender are premium keywords determined by a predetermined criterion of Boyd et al., since it is suggested by Boyd et al. such that, the highest bidder will win the contest if the auction's time expires and make it easier not to rerun auction again (*i.e.*, "Thus, if the seller wants to sell a particular item

when the bid price reaches \$500, the first bidder to bid \$500 (or more) will be awarded the item regardless of whether another bidder may outbid this bidder. On the other hand, if none of the bids reaches the magic \$500 threshold, the highest bidder after the auction time period expires will win the contest."(Par. 236 lines 9-15)).

As per claim 8:

Goino does not explicitly disclose for the tender conditions selectively further include information on network information providers. However, Boyd et al teach a method, **wherein the tender conditions selectively further include information on network information providers or a predetermined display period of time** (*i.e.*, "Auction termination conditions are discussed in greater detail below and include such conditions as expiration of a predetermined time period for the auction (e.g., 72 hours) and premature closing due to inactivity within any specified time period."(Par. 238 lines 7-11)).

Therefore, it would have been obvious to a person in the art at the time the invention was made to modify the method disclosed in Goino to have the tender conditions selectively further include information on network information providers. This modification would have been obvious because a person having ordinary skill in the art, at the time the invention was made, having the teachings of Goino and Boyd et al. before him/her, to modify the method of Goino to

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include the tender conditions selectively further include information on network information providers of Boyd et al., since it is suggested by Boyd et al. such that, the highest bidder will win the contest if the auction's time expires and make it easier not to rerun auction again (*i.e.*, "Thus, if the seller wants to sell a particular item when the bid price reaches \$500, the first bidder to bid \$500 (or more) will be awarded the item regardless of whether another bidder may outbid this bidder. On the other hand, if none of the bids reaches the magic \$500 threshold, the highest bidder after the auction time period expires will win the contest." (Par. 236 lines 9-15)).

9. Claims 16 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Singh et al. United States Patent Publication No.2002/0165849 A1 in view of Boyd et al. United States Patent Publication No. 2004/0193489 A1.

As per claim 16:

Singh et al. do not explicitly disclose for the reselling the keywords includes one of a first-come first-served system, a re-tender system and a next order bidding price selection system. However, Boyd et al teach a method, **further comprising the step of reselling keywords if the successful bid is regarded as an unsuccessful bid, wherein the step of reselling the keywords includes one of a first-come first-served system, a re-tender system and a next order bidding price selection system** (*i.e.*, "Thus, if the seller

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wants to sell a particular item when the bid price reaches \$500, the first bidder to bid \$500 (or more) will be awarded the item regardless of whether another bidder may outbid this bidder. On the other hand, if none of the bids reaches the magic \$500 threshold, the highest bidder after the auction time period expires will win the contest."(Par. 236 lines 9-15)).

Therefore, it would have been obvious to a person in the art at the time the invention was made to modify the method disclosed in Singh et al. to have the keywords includes one of a first-come first-served system, a re-tender system and a next order bidding price selection system. This modification would have been obvious because a person having ordinary skill in the art, at the time the invention was made, having the teachings of Singh et al. and Boyd et al. before him/her, to modify the method of Singh et al. to include the keywords includes one of a first-come first-served system, a re-tender system and a next order bidding price selection system of Boyd et al., since it is suggested by Boyd et al. such that, the highest bidder will win the contest if the auction's time expires and make it easier not to rerun auction again (*i.e.*, "*Thus, if the seller wants to sell a particular item when the bid price reaches \$500, the first bidder to bid \$500 (or more) will be awarded the item regardless of whether another bidder may outbid this bidder. On the other hand, if none of the bids reaches the magic \$500 threshold, the highest bidder after the auction time period expires will win the contest."*(Par. 236 lines 9-15))

As per claim 20:

Singh et al. do not explicitly disclose for the reselling the highest bidding price or the bidding price list is not opened during a predetermined period of time before a tender period of time expires. However, Boyd et al teach a method, **wherein the highest bidding price or the bidding price list is not opened during a predetermined period of time before a tender period of time expires** (*i.e.*, "Alternatively, the merchandise is sold at the highest bid price when the time period for the auction expires." (Par. 236 lines 5-7)).

Therefore, it would have been obvious to a person in the art at the time the invention was made to modify the method disclosed in Singh et al. to have the highest bidding price or the bidding price list is not opened during a predetermined period of time before a tender period of time expires. This modification would have been obvious because a person having ordinary skill in the art, at the time the invention was made, having the teachings of Singh et al. and Boyd et al. before him/her, to modify the method of Singh et al. to include the highest bidding price or the bidding price list is not opened during a predetermined period of time before a tender period of time expires of Boyd et al., since it is suggested by Boyd et al. such that, the highest bidder will win the contest if the auction's time expires and make it easier not to rerun auction again (*i.e.*, "Thus, if the seller wants to sell a particular item when the bid price reaches \$500, the first bidder to bid \$500 (or more) will be awarded the item regardless of whether another bidder may outbid this bidder. On the other hand, if none of the bids reaches the magic \$500 threshold, the highest bidder

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after the auction time period expires will win the contest."(Par. 236 lines 9-15)).

10. Claims 24-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Singh et al. United States Patent Publication No.2002/0165849 A1 in view of Harrison, JR. et al. United States Patent Publication No. 2001/0039524 A1.

As per claim 24:

Singh et al. do not explicitly disclose for the reselling the step of maintaining search list orders including URLs associated with network information providers and image files associated with the network information providers. However, Harrison, JR. et al. teach a method, **wherein the step of maintaining the plurality of search list orders includes the step of maintaining search list orders including URLs associated with network information providers and image files associated with the network information providers** (*i.e.*, "Automatic means of adding an electronic image and accompanying text to an Internet auction listing or other World Wide Web page is also known. For example, the company known as Honesty.com enables Internet auction sellers to visit the Honesty.com Web site, enter an auction site name, auction number, email address and password, and then have the Honesty.com logo and a unique "hit

counter" added to the given auction listing automatically." (Par 14)).

Therefore, it would have been obvious to a person in the art at the time the invention was made to modify the method disclosed in Singh et al. to have the step of maintaining search list orders including URLs associated with network information providers and image files associated with the network information providers. This modification would have been obvious because a person having ordinary skill in the art, at the time the invention was made, having the teachings of Singh et al. and Harrison, JR. et al. before him/her, to modify the method of Singh et al. to include the step of maintaining search list orders including URLs associated with network information providers and image files associated with the network information providers of Harrison, JR. et al., since it is suggested by Harrison, JR. et al. such that, an automated computer network-based will provide a method which the internet sellers can easily perform their sell/buy transaction (*i.e.*, *"The disclosed invention provides an automated, computer-implemented, network-based method by which Internet sellers can obtain either a performance bond or a guaranty in real time and immediately deploy a unique seal evidencing this contractual protection for buyers."* (Par. 17 lines 1-5)).

As per claim 25:

Singh et al. do not explicitly disclose for the reselling the search list orders arranged in the predetermined search list order placement position is arranged with the image files included. However, Harrison, JR. et al. teach a method, **wherein at least one portion of the search list**

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orders arranged in the predetermined search list order placement position is arranged with the image files included (*i.e.*, "The Regenerating Seal. A Web browser "reads" HTML documents so as to display images when a proper reference to particular digital image, stored on a connected server, is made. The typical HTML code appears in a form similar to this: ``." (Par. 151)).

Therefore, it would have been obvious to a person in the art at the time the invention was made to modify the method disclosed in Singh et al. to have the search list orders arranged in the predetermined search list order placement position is arranged with the image files included. This modification would have been obvious because a person having ordinary skill in the art, at the time the invention was made, having the teachings of Singh et al. and Harrison, JR. et al. before him/her, to modify the method of Singh et al. to include the search list orders arranged in the predetermined search list order placement position is arranged with the image files included of Harrison, JR. et al., since it is suggested by Harrison, JR. et al. such that, an automated computer network-based will provide a method which the internet sellers can easily perform their sell/buy transaction (*i.e.*, "The disclosed invention provides an automated, computer-implemented, network-based method by which Internet sellers can obtain either a performance bond or a guaranty in real time and immediately deploy a unique seal evidencing this contractual protection for buyers." (Par. 17 lines 1-5)).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Fariborz Khoshnoodi whose telephone number is 571-270-1005. The examiner can normally be reached on M-Th every other F 8:00-4:00..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tim Vo can be reached on 571-272-3642. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Fariborz Khoshnoodi
Examiner
Art Unit 2168

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TM 3/18/07



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